

REMARKS

Claims 1-19 were pending in the present patent application. Claims 1-19 stand rejected. By this Amendment, claims 9-15 have been cancelled to place the present application in condition for allowance, or otherwise reduce the number of issues on appeal. Applicant expressly reserves the right to pursue the subject matters of claims 9-15 in a Continuation application. This application now includes claims 1-8 and 16-19.

Claims 1-9, 12-14, and 16-19 were rejected under 35 U.S.C. §102(b) as being anticipated by Marple, U.S. Patent No. 1,887,655. The rejection of claims 9 and 12-14 are now moot, in view of their cancellation. Applicant respectfully requests reconsideration of the rejection of claims 1-8 and 16-19 in view of the following.

The Examiner states that Marple '655 teaches Applicant's claim limitations including a liner body, a handle assembly having an insert member, a bore, perimetrical groove, a retaining ring, a spindle assembly- including a stop member, a ramp and a stop surface. Such a list of components, however, does not yield Applicant's claims as being anticipated by Marple.

As set forth in MPEP 2131, "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the ... claim." *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim, but this is not an *ipsissimis verbis* test, i.e., identity of terminology is not required. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Upon consideration of all elements of each claim (*Verdegaal Bros.*), the arrangement of those elements as specified by each claim (*In re Bond*) and the level of detail provided by each claim (*Richardson*), it is Applicant's contention that Marple does not anticipate Applicant's claims.

For example, claim 1 recites a liner body having an insert opening, a handle assembly having an insert member (with a bore) that is inserted into said insert opening of the liner body, and a spindle shaft being mounted to the insert member by its insertion into the bore of the insert member. The Examiner considers item 15 of Marple to correspond to the recited "insert member". However, item 15 of Marple is an inner end handle portion of a one-piece handle 11. Marple discloses a handle 11 that includes a recess 12 formed in inner end portion 15 of handle 11 adapted to receive the end of a stub shaft 8 (page 1, lines 56-58). Thus, the Marple stub shaft 8 is received directly into the handle 11 (Fig. 1), without any intermediary structure corresponding to the "insert member", which itself is inserted into an insert opening in the liner body, as recited in claim 1.

As a further example, in claim 1 it is recited that a stop member extends outwardly from said spindle shaft, that the stop member includes (1) a ramped surface and (2) a stop surface, that the spindle shaft is mounted to the insert member by sliding the spindle shaft into the bore of the insert member in a first direction, and that the stop surface engages the retaining ring to resist removal of the spindle shaft from the bore when the spindle shaft is moved in a second direction opposite to the first direction. The Examiner asserts that in Marple bevel 22 corresponds to the recited "ramp" and that either edge of groove 18 (of handle portion 15; Marple, page 2, lines 10-12) abutting one end 20 of the ring is the "stop surface". However, previous to that, the Examiner asserts that groove 18 of Marple is the recited "perimetrical groove" which in claim 1 is formed in the outer surface of the insert member, which in turn has a bore that receives the spindle shaft.

Accordingly, clearly, groove 18 of Marple which the Examiner contends is in the insert member cannot be part of a “stop member” having both the ramped surface and the stop surface, which extends outwardly from the spindle shaft that is received in the bore of the insert member. In Marple, there is no such spindle shaft having a stop member, wherein the stop member that extends outwardly from the spindle shaft includes both a ramped surface and a stop surface, but rather, discloses a stub shaft 8 having inwardly formed grooves.

Further, while the Examiner interprets certain limitations as functional rather than structural, the Examiner fails to designate with any specificity that which the Examiner considers as functional, leaving Applicant to try to decipher which limitations the Examiner considers as functional. The Examiner is requested to clarify which limitations are not being given patentable weight for being functional.

In many instances, however, as set forth below, the language which the Examiner may consider as functional shows the arrangement of components, which is structural. As set forth above, anticipation requires that the elements of Marple must be arranged as required by the claim.

See, In re Bond.

For example, claim 1 is directed to a handle set. Claim 1 recites a liner body having an insert opening; a handle assembly having an insert member that is inserted into said insert opening, said insert member having an outer surface, a bore, and a perimetrical groove formed in said outer surface extending around a perimeter of said outer surface, said perimetrical groove extending to said bore at least at one location; a retaining ring received in said perimetrical groove; and a spindle assembly including a spindle shaft configured for insertion into said bore of said insert member, said spindle assembly including a stop member extending outwardly from said spindle shaft, said stop member including a ramped surface and a stop surface, said spindle shaft being

mounted to said insert member by sliding said spindle shaft in a first direction into said bore, said stop member being configured such that said stop surface engages said retaining ring to resist removal of said spindle shaft from said bore when said spindle shaft is moved in a second direction opposite to said first direction.

If the Examiner considers the recitation of the “spindle assembly including a spindle shaft configured for insertion into said bore of said insert member” to merely recite a capability, then the Examiner is directed to the additional statement in the same clause that “said spindle shaft being mounted to said insert member by sliding said spindle shaft in a first direction into said bore.” Thus, not only is the spindle shaft configured for insertion into the bore of the insert member, the clause positively recites an arrangement of elements wherein the spindle shaft is slid into the bore to mount the spindle shaft to the insert member. When considered in total, what the Examiner may consider as functional is a recitation of structure.

If the Examiner considers the “stop member being configured” to merely recite a capability, then the Examiner is directed to the additional statement in the same clause that the stop member being configured “such that said stop surface engages said retaining ring to resist removal of said spindle shaft from said bore when said spindle shaft is moved in a second direction opposite to said first direction.” Thus, this clause recites an arrangement of elements as with respect to the stop surface of the stop member (which also has a ramped surface), and the retaining ring, and more particularly, defines a relationship such that “said stop surface engages said retaining ring when the spindle shaft is moved in a second direction opposite to said first direction” so as to resist removal of said spindle shaft from the bore. Thus, again, when considered in total, what the Examiner may consider as functional is a recitation of structure and details of how the various components are arranged, and interact.

Accordingly, claim 1 is believed allowable in its present form.

Claims 2-8 are believed allowable due to their dependence, directly or indirectly, on otherwise allowable base claim 1. In addition, claims 2-8 further and patentably define the invention over Marple.

Claim 2, depending from claim 1, recites that the ramped surface of the stop member engages the retaining ring to expand the retaining ring when the spindle shaft is inserted in the first direction into the bore of the insert member, and that the retaining spring returns to the pre-expansion state after the ramped surface of the outwardly extending stop member passes the retaining ring. This recitation further clarifies the location of the stop member with respect to the spindle shaft and the retaining ring, and clearly and positively recites that the ramped surface engages the retaining ring as the spindle shaft is inserted into the bore. Thus, again, when considered in total, what the Examiner may consider as functional is a recitation of structure. Marple does not include the spindle shaft having the stop member, that extends outwardly from the spindle shaft, that has the ramped surface that engages the retaining ring as the spindle shaft is inserted into the bore, as recited in claim 2. Thus, claim 2 is believed allowable in its own right.

Claim 3 is directed to the handle set of claim 1, wherein said bore of said insert member has a passage for receiving the stop member, i.e., the stop member that extends outwardly from the spindle shaft, as recited in claim 1. As set forth above with respect to claim 1, Marple simply does not disclose, teach, or suggest an insert member or the stop member extending outwardly from the spindle shaft, and thus, does not disclose, teach, or suggest wherein the bore of the insert member has a passage for receiving the stop member, i.e., the stop member that extends outwardly from the spindle shaft, as recited in claim 3. Thus, claim 3 is believed allowable in its own right.

Claim 6 is directed to the handle set of claim 1, further comprising a lock mechanism configured for connection to said spindle shaft, said lock mechanism including a housing, said housing including a shaft opening having a clearance notch formed therein to facilitate passing said stop member of said spindle shaft through said lock mechanism as said spindle shaft is received in said shaft opening.

The Examiner asserts that Marple elements 4 and 5 are a lock mechanism. In contrast to a lock mechanism, the Marple elements 4 and 5 are clearly identified as a casing 4 that contains the Marple operating mechanism that is permanently attached to a plate 5 (page 1, lines 38-40). Marple does not disclose, teach, or suggest that casing 4 and plate 5 are also a locking mechanism. On the contrary, Marple discloses that projecting from the casing is stub shaft 8 having a serrated head 9 which is connected to an arm 10 *to be linked with the door lock proper*. Thus, Marple distinguishes casing 4 and plate 5 from the “*door lock proper*”, which known in the art to be a lock mechanism within the context of automobile door latches (page 1, lines 1-5). Accordingly, Applicant respectfully submits that Marple elements 4 and 5 are not a lock mechanism, as recited in claim 6.

Accordingly, Marple does not disclose, teach, or suggest the subject matter of claim 6. Claim 6 is thus believed allowable in its own right.

Accordingly, for at least the reasons set forth above, Applicant respectfully requests that the rejection of claims 1-8 under 35 U.S.C. 102(b) be withdrawn.

Claim 16 is directed to a handle set. Claim 16 recites, a liner body having an insert opening; a handle assembly having an insert member that is inserted into said insert opening, said insert member having an outer surface, a bore, and a perimetrical groove formed in said outer surface extending around a perimeter of said outer surface, said perimetrical groove extending to

said bore at least at one location; a retaining ring received in said perimetrical groove; and a spindle assembly including a spindle shaft configured for insertion into said bore of said insert member, said spindle shaft being mounted to said insert member by sliding said spindle shaft in a first direction into said bore; and means for engaging said retaining ring to resist removal of said spindle shaft from said bore when said spindle shaft is moved in a second direction opposite to said first direction.

For substantially the same reasons as set forth above with respect to claim 1 relating to the liner body, insert member, and spindle shaft having the outwardly extending stop member, Marple does not disclose, teach, or suggest the subject matter of claim 16.

Accordingly, for at least the reasons set forth above, Applicant respectfully requests that the rejection of claim 16 under 35 U.S.C. 102(b) be withdrawn.

In rejecting claims 17-19 the Examiner states that one of ordinary skill in the art would recognize the broadly-recited steps of assembly of the structures delineated above are inherently taught by the full description and illustration of the invention of Marple '655.

In relying upon the theory of inherency, however, the Examiner provides no basis in fact and/or technical reasoning to support a determination that the allegedly inherent characteristic, i.e., the entirety of claim 17, necessarily will be present if the teachings of Marple '655 are followed.

To establish inherency, the extrinsic evidence "must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." *Continental Can Co. v. Monsanto Co.*, 948 F.2d 1264, 1268, 20 U.S.P.Q.2d 1746, 1749 (Fed. Cir. 1991); emphasis added. "Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient." *Id.* at 1269, 20 U.S.P.Q.2d at 1749

(quoting *In re Oelrich*, 666 F.2d 578, 581, 212 U.S.P.Q. 323, 326 (C.C.P.A. 1981). In the present application, the Examiner has not provided such, and essentially states that the entirety of claims 17-19 is inherent from Marple. As such Applicant contends that the burden of showing that each of the limitations in claims 17-19 are disclosed by Marple '655, either expressly or inherently, has not been satisfied.

Claim 17 is in the form of a method claim, rather than an apparatus claim. Claim 17 is directed to a method of assembling a handle set. Claim 17 recites, a method of assembling a handle set, comprising the steps of: providing a liner body having an insert opening; providing a handle assembly having an insert member, said insert member having an outer surface, a bore, and a perimetrical groove formed in said outer surface extending around a perimeter of said outer surface, said perimetrical groove extending to said bore at least at one location; inserting said insert member into said insert opening; mounting a retaining ring in said perimetrical groove; providing a spindle assembly including a spindle shaft, said spindle assembly including a stop member extending outwardly from said spindle shaft, said stop member including a ramped surface and a stop surface; and sliding said spindle shaft in a first direction into said bore, said ramped surface of said stop member engaging said retaining ring to apply an interior force to said retaining ring to expand said retaining ring, said retaining ring returning to a pre-expansion state after said ramped surface passes said retaining ring, said stop surface engaging said retaining ring to resist removal of said spindle shaft from said bore when said spindle shaft is moved in a second direction opposite to said first direction.

As previously stated, Marple does not disclose the recited insert member, and accordingly, does not disclose, teach or suggest the steps associated with the insert member, as recited in claim 17.

Furthermore, as previously stated, Marple does not disclose a stop member, having a ramped surface and a stop surface, extending outwardly from the spindle shaft, and accordingly, does not

disclose, teach or suggest the steps associated with the stop member, ramped surface and stop surface, as recited in claim 17.

Accordingly, for at least the reasons set forth above, Applicant respectfully submits that claim 17 is allowable in its present form.

Claims 18 and 19 are believed allowable due to their dependence, directly or indirectly, on otherwise allowable base claim 17.

Further, with respect to claims 18 and 19, it is stated that the bore of the insert member has a passage to which the perimetrical groove extends, that the stop member is received in the passage, and in claim 19, that the passage is a keyway. There is no disclosure, teaching or suggestion in Marple that the alleged bore (item 12) has a passage for receiving the stop member (which extends outwardly from the spindle shaft), or that the passage is a keyway.

Accordingly, for at least the reasons set forth above, Applicant respectfully requests that the rejection of claims 17-19 under 35 U.S.C. 102(b) be withdrawn.

Claims 9-14 were rejected under 35 U.S.C. §102(b) as being anticipated by Solliday, U.S. Patent No. 1,862,716. In view of the cancellation of claims 9-14, this rejection is now moot.

Claims 9-11 and 15 were rejected under 35 U.S.C. §102(b) as being anticipated by Gater, et al., U.S. Patent No. 4,672,829. In view of the cancellation of claims 9-11 and 15, this rejection is now moot.

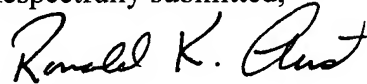
Applicant believes that the present application is in condition for allowance in its present form, and it is respectfully requested that the Examiner so find and issue a Notice of Allowance in due course.

In the event Applicant has overlooked the need for an extension of time, an additional extension of time, payment of fee, or additional payment of fee, Applicant hereby conditionally

petitions therefor and authorizes that any charges be made to Deposit Account No. 20-0095,
TAYLOR & AUST, P.C.

Should any question concerning any of the foregoing arise, the Examiner is invited to
telephone the undersigned at (317) 894-0801.

Respectfully submitted,



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